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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/764,313	01/23/2004	Patricia L. Redding	7270	8167

7590

02/28/2005

The Sherwin-Williams Company  
Legal Dept.  
11 Midland Bldg.  
101 Prospect Avenue, N.W.  
Cleveland, OH 44115

EXAMINER

KOSLOW, CAROL M

ART UNIT

PAPER NUMBER

1755

DATE MAILED: 02/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/764,313

Applicant(s)

REDDING, PATRICIA L.

Examiner

C. Melissa Koslow

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 14 and 15 is/are allowed.
- 6) ☒ Claim(s) 1,3-6,8,9 and 16 is/are rejected.
- 7) ☒ Claim(s) 2,7 and 10-13 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 January 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 2/3/05, 7/12/04.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

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The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the description: Reference number 22. Corrected drawing sheets in compliance with 37 CFR 1.121(d), or amendment to the specification to add the reference character(s) in the description in compliance with 37 CFR 1.121(b) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Applicant's claim for domestic priority under 35 U.S.C. 119(e) is acknowledged. However, the provisional application upon which priority is claimed fails to provide adequate support under 35 U.S.C. 112 for claims 3 and 4 of this application.

The provisional application does not support claims 3 and 4 since it only teaches modified alkyd resins, not the claimed generic alkyd resins, which include all alkyd resins.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over GB 2,119,518 in view of U.S. patent 4,923,097.

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GB 2,119,518 teaches an aerosol spray paint composition comprising at least one volatile organic solvent; at least one film-forming resin, ferromagnetic iron oxide particles, titania particles, which is a whitening pigment, and a fluorochlorocarbon propellant. The taught composition is in a conventional aerosol paint container, which is that claimed. One of ordinary skill in the art would want to replace the taught fluorochlorocarbon propellant with one that is more environmentally friendly, especially in light of the fluorochlorocarbons are being phase out of use due to their negative effect on the environment. U.S. patent 4,923,097 teaches dimethyl ether propellants are effective paint propellant and that it is not harmful. Therefore, one of ordinary skill in the art would have found it obvious to replace the taught fluorochlorocarbon with a dimethyl ether propellant. The references suggest the claimed composition.

Claims 1, 3-6, 8, 9 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. patent 4,923,097 in view of U.S. patent 2,895,851.

U.S. patent 4,923,097 teaches an aerosol paint composition comprising a dimethyl ether propellant, a volatile organic solvent, a vinyl toluene modified alkyd resin and pigments in a conventional aerosol paint container, which is the claimed container. There is no indication that the paint contains water, thus it is assumed it is substantially free of water. U.S. patent 4,923,097 does not teach that the pigment can be ferromagnetic pigments. U.S. patent 2,895,851 teaches a sprayable magnetic paint comprising a resin, a volatile organic solvent and a pigment composition of ferromagnetic particles in combination with a whitening pigment or silica, which is an extender pigment. Given this teaching and if one of ordinary skill in the art wished to produce a magnetic aerosol paint, one of ordinary skill in the art would have found it obvious to use the magnetic pigment of U.S. patent 2,895,851 as the pigment in paint composition of U.S.

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patent 4,923,097. This suggested composition is that claimed. One of ordinary skill in the art would expect that when this composition is applied to a surface by the claimed conventional method, that the resulting surface would have magnetic properties, absent any showing to the contrary. The references suggest the claimed process.

Claims 14 and 15 are allowable over the cited art of record.

Claims 2, 7 and 10-13 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

There is no teaching of suggestion in the cited art of record of a paint composition having the composition of claims 10, 14 and 15. The maximum amount of ferromagnetic particles taught in the cited art of record is 20 wt%, based on the amount of solvent, resin and magnetic particles. There is no teaching or suggestion in the cited art of record of a magnetic aerosol paint where the propellant is a blend of n-butane and propane or a magnetic aerosol paint comprising a desiccant or an antistatic agent. There is no motivation in the cited art of record to limit the size of the magnetic particles to the claimed ranges since the conventional particle size of the pigments used in aerosol paints is up to 500 microns.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Melissa Koslow whose telephone number is (571) 272-1371. The examiner can normally be reached on Monday-Friday from 8:00 AM to 3:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jerry Lorengo, can be reached at (571) 272-1233.

The fax number for all official communications is (703) 872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

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applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

cmk  
February 25, 2005



C. Melissa Koslow  
Primary Examiner  
Tech. Center 1700